

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

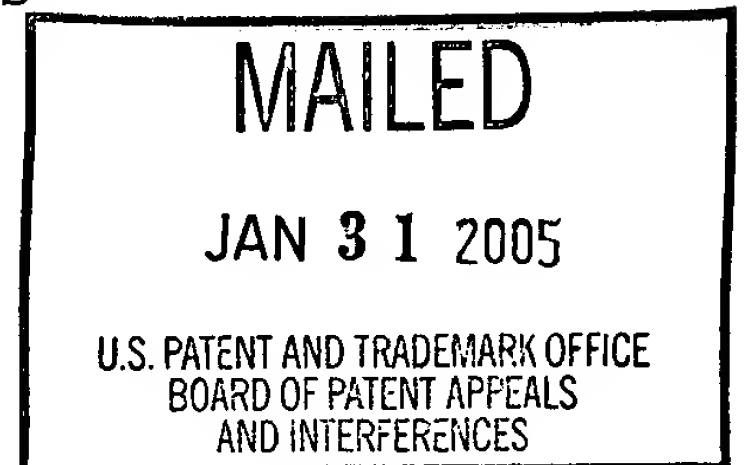
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUNG-SOO KIM

Appeal No. 2005-0182
Application No. 09/783,392

ON BRIEF



Before WARREN, OWENS, and WALTZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 7, 9 and 10.¹ Claim 8 is the only other claim pending in this application and stands withdrawn from further consideration as directed to a non-elected invention (Brief, page 2, ¶(III); final Office action dated Mar. 11, 2003, page 1). We have jurisdiction pursuant to 35 U.S.C. § 134.

¹Claims 5 and 8 were amended to correct informalities in an amendment subsequent to the final rejection (see the amendment dated Sep. 11, 2003, entered as per the Advisory Action dated Oct. 2, 2003; and the Brief, page 2, ¶(IV)).

Appeal No. 2005-0182
Application No. 09/783,392

According to appellant, the invention is directed to a seat belt with a printed face at the outer side, where the printed face is a character, a mark or a pattern which prevents the user's hands from slipping while maintaining the general function of the seat belt (Brief, page 2). Appellant states that the claims "are deemed to be individually patentable" (Brief, page 3). To the extent appellant has presented specific, substantive arguments for the patentability of individual claims, we will consider these claims separately. See 37 CFR § 1.192(c)(7)(2003); *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002).

Representative independent claim 1 is reproduced below:

1. A seat belt with a printed face for a vehicle, in which a printed face of a character, a mark and a pattern is formed on one face of the seat belt formed [sic] a band shape woven with polyester at a location selected to be grasped by a user when fastening the seat belt, the printed face being embossed to prevent slippage from the user's grip and to facilitate the putting on and taking off of the seat belt.

Appeal No. 2005-0182
Application No. 09/783,392

The examiner has relied upon the following references as evidence of obviousness:

Cave	262321 ²	Feb. 06, 1964
(published Australian Patent Specification)		

Miyamoto	2186612 A	Aug. 19, 1987
(published Great Britain Patent Application)		

Claims 1-7, 9 and 10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over either Cave or Miyamoto (Answer, page 3). We affirm both of these rejections on appeal essentially for the reasons stated in the Answer and those reasons set forth below.

OPINION

The examiner finds that both Cave (figure 1) and Miyamoto (figure 4) teach the use of characters, marks or patterns on a seat belt, and thus provide a "printed face" that may be readily grasped and inherently prevents or at least lessens to some degree slippage from the user's grip due to the nature of the "printed face" (Answer, page 3). The examiner further finds that the material that forms the seat belt, as well as the type and color of the

²The examiner incorrectly lists this document as "2,623,321" on page 3 of the Answer. However, appellant correctly lists this document on page 3 of the Brief. Therefore we hold this error to be harmless.

Appeal No. 2005-0182
Application No. 09/783,392

characters or marks on the belt, would have been obvious to one of ordinary skill in the art (*id.*).

Appellant first argues that "inherency" cannot be applied under section 103 but is limited only to anticipation rejections (Brief, page 4; Reply Brief, page 2). Then appellant argues that the examiner has not established that the belt treatments in each reference would necessarily produce less slippage in each and every case (*id.*).

These arguments are not persuasive. As held by a predecessor of our reviewing court:

[I]t is elementary that the mere recitation of a newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. [Citation omitted]. This burden ... is applicable to product and process claims reasonably considered as possessing the allegedly inherent characteristics.³

³*In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977), quoting *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971); see also *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975) (Merely choosing to describe the invention in terms of certain physical characteristics does not render patentable an otherwise obvious method); *In re Spada*, 911 (continued...)

We determine that the examiner has established a reasonable belief that the seat belts of Cave and Miyamoto possess the characteristic or function "to prevent slippage from the user's grip" as required by claim 1 on appeal. Both references teach a "printed face" which is "embossed", i.e., a character, mark or pattern is raised from the surface of the seat belt, as required by claim 1 on appeal.⁴ Miyamoto discloses a pattern of high visibility material 2 attached to the surface of the seat belt by stitching or chemical bonding (page 1, ll. 29-39). As seen from Figure 3, the high visibility material 2 is raised in relief from the surface 1 of the seat belt. Similarly, Cave discloses applying a fiber pile in the form of a pattern to one or both sides of a seat belt (page 2, ll. 1-2, 6-7, and 21-22). This fiber pile of Cave is disclosed as "upstanding" (page 3, l. 7) and, as shown by Figures 2 and 3, is raised in relief from the surface of the seat belt. Accordingly, the examiner has shown reasonable belief that the embossed "printed faces" of Cave and Miyamoto would prevent, to some extent, slippage

³(...continued)
F.2d 705, 708, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

⁴"Embossed" is defined in the specification as "solidly displayed, stands out on the seat belt" (page 7, l. 20, and page 8, ll. 19-22). The ordinary meaning of "embossed" is "to raise in relief from a surface ... either by carving or handiwork, or ... mechanical means." *Webster's Third New International Dictionary*, p. 740, Gove, ed., G. & C. Merriam Co., 1971.

Appeal No. 2005-0182
Application No. 09/783,392

of the seat belt from the user's grip (see the Answer, sentence bridging pages 3-4). We note that the extent or amount of slippage prevented is not recited in claim 1 on appeal. We further note that the location of any embossed pattern has only been specified as "a location selected to be grasped by a user" (see claim 1 on appeal), thus reading on any location on the seat belt (Answer, page 4).

Appellant argues that the fiber pile of Cave is used for the purpose of attenuating the normal effect of a seat belt rubbing abrasively on a user's clothing, and has no other function (Brief, page 4). Appellant further argues that there is no disclosure in Cave that the pile has any effect on the grip and, without any disclosure as to the coefficient of friction produced by the pile, it cannot be assumed that a better grip will result (Brief, page 5). Similarly, appellant argues that the purpose of the belt arrangement taught by Miyamoto is different from that of the claimed subject matter (Brief, page 6). Appellant alleges that the coefficient of friction of the high visibility material seat belt arrangement of Miyamoto "may very well be lower" than the normal belt surface (*id.*).

Appeal No. 2005-0182
Application No. 09/783,392

These arguments are not persuasive. The examiner has established that the prior art seat belts with their separate raised surfaces are identical or substantially identical to the subject matter as set forth in claim 1 on appeal, namely a seat belt with an embossed printed face on one side (Answer, pages 3-4). Merely claiming a new function or purpose of the seat belt treatments of the prior art does not render the claims patentable (Answer, page 4; see *In re Best*, supra). As set forth by the court in *In re Best*, 562 F.2d at 1255, 195 USPQ at 433-34:

Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. See *In re Ludtke*, supra. Whether the rejection is based on "inherency" under 35 USC 102, on "prima facie obviousness" under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products. [footnote omitted].

As discussed above, we determine that the examiner has met the initial burden of proof and shifted this burden to appellant. Appellant's assertion that the coefficient of friction of the prior art seat belt "may very well be lower" is not supported by any objective evidence.


Appeal No. 2005-0182
Application No. 09/783,392

Appellant further argues the various limitations of the dependent claims (Brief, pages 7-9; Reply Brief, pages 2-4). As noted by the examiner (Answer, page 4), these various limitations are considered conventional or well known in the art. The use of multicolor patterns, as recited in claims 4 and 9, would have been suggested by the teaching in Cave of differently colored fibers (page 2, ll. 15-19). It is the product which is being claimed, and appellant has not established that the process by which it is formed affects the product as claimed (i.e., silk printing in claim 6 and decalcomania in claim 7). See *In re Wertheim*, 541 F.2d 257, 271, 191 USPQ 90, 103 (CCPA 1976). Furthermore, the material used to make the "printed face" would have been well within the ordinary skill in the art, depending on the properties desired (see claims 2, 3 and 5).

For the foregoing reasons, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellant's arguments, we determine that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm the examiner's rejections of the claims on appeal under 35 U.S.C. § 103(a) over Cave or Miyamoto.

Appeal No. 2005-0182
Application No. 09/783,392

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

AFFIRMED

Charles F. Warren
Administrative Patent Judge

Terry J. Owens
Terry J. Owens
Administrative Patent Judge

Thomas A. Waltz
Administrative Patent Judge

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Appeal No. 2005-0182
Application No. 09/783,392

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